UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,889	11/22/1999	MICHAEL G. MIKURAK	AND1P367	9216

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EXAMINER
VAN DOREN, BETH

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 04/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/444,889	MIKURAK, MICHAEL G.
	Examiner	Art Unit	
	Beth Van Doren	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 January 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>17,18,21-23,26-28 and 31-37</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>17,18,21-23,26-28 and 31-37</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>20041214</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection on 01/04/2005. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37

CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn

pursuant to 37 CFR 1.114. Applicant's submission filed on 12/03/04 has been entered.

2.   Claims 17, 22, and 27 have been amended in the submission received on 12/19/03.

Claims 17-18, 21-23, 26-28, and 31-37 are pending in the current application.

Response to Amendment

3.   Applicant's amendments to claims 17, 22, and 27 are sufficient to overcome the 35 USC

§ 112, second paragraph, rejections set forth in the previous office action. However, new 35

USC § 112, second paragraph, rejections have been established below.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

5.   Claims 17-18, 21-23, 26-28, and 31-37 are rejected under 35 U.S.C. 112, first paragraph,

as failing to comply with the written description requirement. The claims contains subject matter

which was not described in the specification in such a way as to reasonably convey to one skilled

in the relevant art that the inventors, at the time the application was filed, had possession of the

claimed invention.

Claims 17-18, 21-23, 26-28, and 31-37 include the term "framework manager". The subject matter relating to a framework manager was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Furthermore, it would be unclear to one skilled in the relevant art as to what specifically a "framework manager" is (i.e. a person, software, etc.).

Furthermore, the specification does not disclose support for the steps of claims 17, 22, and 27 used together to perform one coherent method or system. Specifically, pages 25 and 26 of the specification disclose the term "framework" as a generic application and a collection of cooperating classes that make up a reusable design solution for a given problem domain. The specification then goes on in pages 46-47 and in figure 11 to discuss the scheduling steps of claims 17, 22, and 27. In summary, this section discloses one or more notices of recommended maintenance and service are received using a network from one or more manufacturers and one or more requests for maintenance and service are received utilizing the network from one or more service providers. Maintenance and service is scheduled using the notices and the requests. The schedule is transmitted to the manufacturers and the service providers using the network in operation. The availability of the manufacturers may be monitored and the manufacturers are scheduled based on their availability. In another embodiment of the present invention, the progress of the manufacturers in completing scheduled maintenance and service may be monitored and the schedule adjusted according to the progress of the manufacturers. The adjusted schedule is then transmitted using the network to the manufacturers and the service providers. Skipping ahead to page 438 of the specification, receiving feedback from users is discusses, however this feedback is from users of a website, not from "framework users" such as

manufacturers and service providers who have had scheduled maintenance performed. Figure

104 and page 435 discuss steps (i) and (ii) of the claims 17, 22, and 27, disclosing the updating

and the synchronizing elements. These elements, however, are part of a method for

administrating an e-Commerce system on a network, and have no connection to scheduling

maintenance and service between a service provider and a manufacturer, wherein a notice is

received from a first user and a request is received for a second user in order to create and

transmit a schedule. In contrast, this section of the specification discloses items including

merchandising content, currency exchange rates, tax rates, and/or pricing of an e-commerce

system that are updated at predetermined intervals. Further, the specification discloses that

entities including server processes, disk space, memory availability, CPU utilization, access time

to a server, and/or a number of connections of the e-commerce system are monitored and not

specifically optimized during any scheduled maintenance and service. Examiner was unable to

find any recitation of using these disparate pieces and steps in one cohesive method and/or

system. In contrast, the specification seems to disclose a scheduling function concerning

manufacturers and service providers using a supply-chain network very separately from the data

updating and synchronizing performed for an e-commerce website.

Appropriate clarification (including reference to supporting excerpts from the

specification) and/or correction (e.g. in the form of claim amendments) are required.

6.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

    The specification shall conclude with one or more claims particularly pointing out and distinctly
    claiming the subject matter which the applicant regards as his invention.

Claims 17-18, 21-23, 26-28, and 31-37 are rejected under 35 U.S.C. 1 12, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

Claims 17-18, 21-23, 26-28, and 31-37 incorporate the term "framework manager." As

explained above, it is unclear as to what specifically a framework manager is or entails.

As per claim 17, without understanding what, specifically, a "framework manager" is, it

is unclear as to how a method can cause a "framework manager'" to use a network to perform the

steps in the body of the claim. Claim 17 specifically recites "causing the framework manager

using the network to:" in the body of the claim, without any preceding steps of how or what

"causes" the manager to perform the steps. For example, if the framework manager is software

then some event or person must enact the framework manager to perform its programmed

functionality.

As per claim 22, a system cannot comprise a single element nor can it comprise software

per se. The "logic" recited in the body of the claim is interpreted as software code, which is per

se software. Therefore, claim 22 only contains software that causes a framework manager (i.e.

person, software?) to perform the steps recited. Therefore claim 22 lacks any system elements

and is therefore improper system claims. Additionally, claim 27 recites that a "code segment"

causes the "framework manager using a network to" perform the listed steps, however, it is not

clear how a single code segment can perform all of the listed functions or how code segment

could cause a person to perform the listed functionality if indeed a "framework manager" is a

person. Further, since the "code segment" is not specifically executed, the claim is directed

towards software per se.

Therefore, since it is unclear what specifically and particularly is being claimed and since

claims 18, 21, 23, 26, 28, and 31-37 depend from claims 17, 22, and 27 and contain similar

deficiencies, claims 17-18, 21-23, 26-28, and 31-37 are rejected under 35 U.S.C. 112, second

paragraph. Correction is required.

Claim Objections

7.   Claims 17, 22, and 27 are objected to because element (d) in each instance has an omitted

word. The limitation "and at least the second framework who requested maintenance and

service" should more appropriately recite --and at least the second framework <u>user</u> who

requested maintenance and service--. Correction is required.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

9.   Claims 22-23, 26-28, 31, and 34-37 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of (1) whether the invention is

within the technological arts and (2) whether the invention produces a useful, concrete, and

tangible result.

For a claimed invention to be statutory, the claimed invention must be within the

technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the

"progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences,

for example) and therefore are found to be non-statutory subject matter. The recited process must

somehow apply, involve, use, or advance the technological arts in order to be statutory.

In the present case, the logic recited in claims 22, 23, 25, and 34-35 are deemed to be

software per se, which is non-statutory. The rationale for the term "circuit logic" being

construed as software per se is set forth in the 35 USC § 112 rejections above

Further, in the present case, the unexecuted code segments in claims 27, 28, 31, and 36-

37 are interpreted to be software per se, which is non-statutory. The rationale for the

interpretation of "code segment" being construed as software per se is set forth in the 35 USC §

112 rejections above. Appropriate correction is required.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 17-18, 21-23, 26-28, and 31-37 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Sekizawa (U.S. 6,430,711) and Haluska (U.S. 5,638,519).

11.   As per claim 17, Sekizawa discloses a method for a framework manager to provide

maintenance and service for a network-based supply-chain framework between a first framework

user and a second framework user such as service providers, vendors, resellers manufacturers

and the like, comprising:

        causing the framework manager using a network to:

(a) receive from a first framework user at least one notice for recommended maintenance and service (See at least column 9, lines 30-40, column 19, lines 1-15, and column 26, lines 10-20, which discloses a first framework user. See at least column 2, lines 50-67, column 3, lines 1-25, column 4, lines 50-65, column 5, lines 40-50, and column 6, lines 55-65, wherein the manufacturer would recommend maintenance and service using the network);

(b) receive from a second framework user at least one request for maintenance and service (See at least figure 28 and column 2, lines 50-67, column 3, lines 1-28, column 4, lines 50-65, column 5, lines 5-10 and 40-50, and column 6, lines 1-6 and 55-65, column 7, lines 25-50, and column 8, lines 1-17, wherein the second framework user requests maintenance and service);

(c) schedule maintenance and service using the at least one notice and the at least one request (See at least column 2, lines 50-67, column 3, lines 1-25, column 4, lines 50-65, column 5, lines 40-50, and column 6, lines 55-65, column 7, lines 59-67, and column 8, lines 1-36, wherein maintenance and service is scheduled using the request and notice);

(d) transmit the schedule to at least the first framework user who recommended maintenance and service and at least the second framework who requested maintenance and service (See at least figure 28 and column 2, lines 50-67, column 3, lines 1-28, column 4, lines 50-65, column 5, lines 40-60, and column 6, lines 55-65, column 7, lines 59-67, and column 8, lines 1-36, wherein the scheduling is made known to the manufacturer and the second framework user via the status views of the network or direct communication);

(e) perform scheduled maintenance and service comprising the steps of:

(i) update internal data items stored in the framework (See at least column 4, lines 5-25 and 40-62, column 7, lines 35-50, and column 8, lines 1-7, wherein the internal data items of the local framework are updated);

(ii) synchronize external data stored separately from the network-based supply chain with internal data stored on the network-based supply chain (See at least column 4, lines 5-25 and 40-62, column 7, lines 35-50, and column 8, lines 1-7, wherein the external, global, data and the local data is synchronized); and

(iii) send feedback response requests to the first framework user and the second framework user of the network-based supply-chain framework (See at least figures 4, 9-12, and 30, column 7, lines 59-67, column 19, lines 35-45, column 20, lines 40-67, column 21, lines 1-10, column 22, lines 25-55, column 23, lines 1-30, column 33, lines 35-65, column 34, lines 55-67, and column 35, lines 1-25, wherein the user is given a change request and there is a mail box for receiving change requests. Also, the user can input information requested by the system, such as error information, status information, customer information, etc.).

(iv)   optimize at least one operation of the framework selected from the group consisting of server processes, disk space, memory availability, CPU utilization access time to a server, and a number of connections in a network-based supply chain for efficient system-operation and problem prevention (See at least figure 20 and column 2, lines 50-67, column 3, lines 1-25 and 45-55, column 5, lines 40-50, and column 6, lines 55-65, wherein at least one operation of the framework is monitored for optimization, including memory availability);

However, Sekizawa does not expressly disclose and Haluska discloses:

(f)   update internal data items stored in the framework selected from the group consisting of merchandising content, currency exchange rates, tax rates, and pricing information (See at least figures 4-6, column 3, lines 25-40 and 45-65, column 5, lines 1-25, column 7, lines 35-60, and column 11, lines 35-65, wherein pricing information is updated);

Both Haluska and Sekizawa disclose manufacturers providing services and supplies to users of the network. Sekizawa further discloses the ability to update internal information such as the customer information. It is well known in marketing and sales to customize merchandising content and/or pricing information to the customer and the customer's information. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to update at least the merchandising content and/or the pricing information based on this change in customer information in order to more efficiently meet the needs of the customers of the system by maintaining universal and updated information accessible by all users of the network that correctly matches the needs/information about the customers. See at least column 2, lines 50-67, of Haluska and column 2, lines 45-67, of Sekizawa.

12.   As per claim 18, Sekizawa teaches a method further comprising the framework manager using the network to perform load-balancing services that initiate and stop processes as utilization levels vary in the network-based supply chain (See at least column 6, lines 10-35, which discloses load balancing).

13.   As per claim 21, Sekizawa teaches a method, where the step of performing scheduled maintenance and service-includes using the network prior to the synchronization of the external data to perform a search for the internal data in the network-based supply chain (See at least column 4, lines 5-25 and 40-62, column 7, lines 35-50, and column 8, lines 1-7, wherein the status data of the local machines are searched prior to the synchronization).

14.   As per claim 32, Sekizawa teaches a method wherein the step of performing scheduled maintenance and service includes indexing received feedback from framework users (See at least figures 4, 9-12, and 30, column 7, lines 59-67, column 19, lines 35-45, column 20, lines 40-67, column 21, lines 1-10, column 22, lines 25-55, column 23, lines 1-30, column 33, lines 35-65,

column 34, lines 55-67, and column 35, lines 1-25, wherein the user is given a change request, the system has a mail box for receiving change requests, and the system saves this data).

15.   As per claim 33, Sekizawa teaches a method wherein the internal data stored in the network-based supply-chain framework is indexed according to each framework user's profile (See at least figures 4, 9-12, and 30, column 7, lines 59-67, column 19, lines 35-45, column 20, lines 40-67, column 21, lines 1-10, column 22, lines 25-55, column 23, lines 1-30, column 33, lines 35-65, column 34, lines 55-67, and column 35, lines 1-25, wherein information is entered in the system and saved based on the user profile. For example, the user is given a change request, the system receives change requests, and the system saves this data with the profile of the user).

16.   Claims 22-23, 26, and 34-35 recite equivalent limitations to claims 17-18, 21, and 32-33, respectively, and are therefore rejected using the same art and rationale as applied above.

17.   Claims 27-28, 31, and 36-37 recite equivalent limitations to claims 17-18, 21, and 32-33, respectively, and are therefore rejected using the same art and rationale as applied above.

Response to Arguments

18.   Examiner would first like to point out that Applicant states that claims 17-37 are pending on page 11, sections 1 and 3. This status information is incorrect. Claims 17-18, 21-23, 26-28, and 31-37 are pending in the current application.

19.   Applicant's arguments with regards to the rejections based on Sekizawa (U.S. 6,430,711) and Haluska (U.S. 5,638,519) have been fully considered, but they are not persuasive. In the remarks, Applicant argues that Sekizawa does not teach or suggest (1) submitting feedback requests to separate users of the framework , (2) the receipt of notices for recommended maintenance as a mechanism to schedule maintenance or a separate framework user

recommending maintenance, (3) two distinct operational framework users, and that (4) Haluska does not teach or suggest feedback or input from multiple users.

In response to argument (1), Examiner respectfully disagrees. Examiner first points out that the claim recites "a method for a framework manager to provide maintenance and service for a network-based supply-chain framework between a first framework user and a second framework [...], comprising: causing the framework manager using a network to:", "(f) perform scheduled maintenance and service comprising the steps of" updating internal data items stored in the framework, synchronizing external data stored separately with internal data, and "(iii) send[ing] feedback response requests to the first framework user and the second framework user of the network-based supply-chain framework". Examiner points out that is unclear, as discussed above in the 112 rejections, how element f(iii) relates to steps f, f(i), and f(ii) or how element f(iii) relates to the rest of the claim. Further, Sekizawa discloses the limitation by discussing sending a user of the network a change request and the user replying to the change request, thereby updating the records of the system. The user of Sekizawa is a customer associated with maintenance requests. See at least column 19, lines 35-45, column 20, lines 40-67, column 21, lines 1-10, column 22, lines 25-55, column 23, lines 1-30, column 33, lines 35-65, column 34, lines 55-67, and column 35, lines 1-25.

In response to argument (2), Examiner respectfully disagrees. Sekizawa discloses a first framework user. See at least column 9, lines 30-40, column 19, lines 1-15, and column 26, lines 10-20. The manufacturer would recommend maintenance and service using the network, as discussed in column 2, lines 50-67, column 3, lines 1-25, column 4, lines 50-65, column 5, lines 40-50, and column 6, lines 55-65.

In response to argument (3), See at least column 9, lines 30-40, column 19, lines 1-15, and column 26, lines 10-20, which discloses a first framework user. See at least figure 28 and column 2, lines 50-67, column 3, lines 1-28, column 4, lines 50-65, column 5, lines 5-10 and 40-50, and column 6, lines 1-6 and 55-65, column 7, lines 25-50, and column 8, lines 1-17, wherein the second framework user requests maintenance and service. Service personnel are sent from a service provider the machine on the network of the second framework user.

In response to argument (4), Examiner respectfully disagrees. Examiner did not rely on Haluska to teach the feedback or multiple user limitations of the claims. Examiner maintains the rejections set forth above and the response to argument 1.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Toyouchi et al. (U.S. 6,006,251) discloses a first user making a request and a second user at a service providing computer.

Cheng et al. (U.S. 6,151,643) teaches a first user recommending updates to a system user concerning software.

Nakagawa et al. (U.S. 5,835,911) teaches a software distribution/maintenance system that interacts with a technical framework that allows a vendor and a user to interact.

Lumelsky et al. (U.S. 6,516,350) teaches a system that manages distributed resources such as CPUs, storage, and servers, for global and local clients.

Waclawsky et al. (U.S. 5,493,689) discloses network analysis and recommendations for network service.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882.

The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bvd

March 24, 2005

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